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35 U.S.C. § 112

Claims 1 and 8 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Claims 2-7 and 9-13 are rejected under 35 U.S.C. § 112, second paragraph, for the same reasons. The Examiner alleges that the phrases "constructed to define", "formed to provide", "formed to produce", "constructed to provide", and "constructed to inhibit" render these claims indefinite because it cannot be determined what structural feature or features, if any, these phrases require. Applicant respectfully disagrees.

It is well established Patent Law that the pending claims must be given the broadest reasonable interpretation consistent with the specification. Also, the words of the claim must be given their plain meaning unless applicant has provided a clear definition in the specification. In *re Zletz*, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989). This of course means that the Examiner, as well as the appellant, must give the words of the claim their plain meaning. Further, the term "plain meaning" means that the words must be read as they would be interpreted by those of ordinary skill in the art. In *re Sneed*, 218 USPQ 385 (Fed. Cir.

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1983).

Applying the above rules to the limitation rejected by the Examiner as indefinite or functional, one must first ask: How would one of ordinary skill in the art interpret this language? The answer must be that any person skilled in the art would immediately recognize the fact that the phrases "constructed to define", "formed to provide", "formed to produce", "constructed to provide", and "constructed to inhibit" include either the verb "constructed" or "formed" modified by an obviously incomplete prepositional phrase (i.e. "to define", "to provide", "to produce", "to provide", and "to inhibit"). Since "define", "provide", "produce", and "inhibit" are verbs, proper English dictates that they be modified by a noun or a phrase acting as the object of the verb. Thus, that skilled artisan would look further to complete the thought and find the object.

In his search the skilled artisan would discover from the claim that the phrase "constructed to define" is modified by the noun phrase: "an insulated and substantially water impermeable food warming chamber". Note that the noun phrase is specific structure. Thus, the

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verb "define" in the prepositional phrase is modified by the noun phrase to make it complete and the verb "constructed" is modified by the complete prepositional phrase to make it complete. Clearly, the claimed structure would always be interpreted by a skilled artisan to include the specific object of the verb and not simply end in an unfinished statement that the units are "constructed to define".

Applying the above rules to the word "pouch", it can be determined from the *Webster's New Universal Unabridged Dictionary* that the first or primary meaning is "a bag, sack, or similar receptacle, esp. one for small articles or quantities." Since applicant has not provided a clear definition in the specification, the words of the claim must be given their plain meaning. *In re Zletz*. Thus, since a pouch is already defined as a bag, sack, or receptacle, any of which clearly define a chamber, the questioned phrase is definite in that it specifies a pouch constructed to define a chamber. The variation is that the pouch includes "a layer formed of a film of plastic material", which obviously makes the chamber "an insulated and substantially water impermeable food warming chamber". This language does not make the claim indefinite since one

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skilled in the art would immediately understand how it was constructed.

Thus, the structural feature clearly set forth in the first allegedly indefinite phrase is: "the pouch being constructed to define an insulated and substantially water impermeable food warming chamber". The pouch includes a layer formed of a film of plastic material. Applicant does not believe that constructing a pouch with a film of plastic material to define an insulated and substantially water impermeable food chamber is indefinite because it cannot be determined what structural feature this phrase requires. This is especially true since the Examiner has already accepted as definite the phrase previously in claim 1: "the pouch bounds an insulated and substantially water impermeable food warming chamber".

Further, in the second allegedly indefinite phrase the skilled artisan would discover from the claim that the phrase "formed to provide" is modified by the noun phrase: "a passive, non-sealing engagement between the lips". This again sets forth specific structure and is definite, especially since the Examiner has already accepted as definite the phrase "a passive, non-sealing engagement

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between the lips", which was previously in the claim.

In the third allegedly indefinite phrase (apparently in claim 8), the skilled artisan would discover from the claim that the phrase "formed to produce" is modified by the noun phrase: "a passive, non-sealing engagement between the lips". This phrase is similar to the above discussed phrase "formed to provide" and all of the above arguments apply.

In the fourth allegedly indefinite phrase (apparently in claim 8), the skilled artisan would discover from the claim that the phrase "constructed to provide" is modified by the noun phrase "a partial vapor lock in the food warming chamber", which is specific structure.

In the fifth allegedly indefinite phrase the skilled artisan would discover from the claim that the phrase "constructed to inhibit" is modified by the noun phrase "a build-up of moisture vapor produced from warm food disposed in the warming chamber". Thus, the skilled artisan would understand that the partial enclosure is constructed to inhibit a build-up of moisture vapor in the warming chamber. This is definite language describing specific

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structure. Previously, the Examiner accepted as definite the language "the partial enclosure . . . inhibiting moisture vapor from warm food disposed in the warming chamber from building-up in the warming chamber".

As explained above, the objects of all of the phrases selected by the Examiner as indefinite were included in the claims, as amended the first time. At that time the Examiner alleged that these various phrases were functional language and did not distinguish applicant's structure from the cited art. Accordingly, applicant amended his claims to make the alleged functional statements part of the structure. It is improper to continue to ignore the alleged functional statements and to reject the claims as indefinite on the basis of a partial and clearly grammatically incorrect phrase.

Applicant strongly asserts that these limitations must be considered by the Examiner and cannot simply be ignored. Even if, *arguendo*, the phrases were functional, "It is well settled that there is nothing intrinsically wrong in defining something by what it does rather than by what it is." *In re Echerd* 471 F.2d 632, 176 USPQ 321 (CCPA 1973); *In re Swinehart*, 58 CCPA 1027, 439 F.2d 210, 169 USPQ 226

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(1971); *In re Fuetterer*, 50 CCPA 1453, 319 F.2d 259, 138 USPQ 217 (1963). "Product claims may be drafted to include process steps to wholly or partially define claimed product, to extent that process limitations distinguish products over prior art, they must be given same consideration as traditional product characteristics." *In re Luck*, 476 F.2d 650, 177 USPQ 523 (CCPA 1973). In *Ex parte Stanley*, 121 USPQ 621, the Patent Office Board of Appeals stated "We will not sustain this latter ground of rejection. The examiner apparently accepts as being proper a "means" coupled with a function. Under the particular circumstances of the present case the term "device" with respect to its significance and coverage is synonymous with the term "means", in these claims to the apparatus. Accordingly, the term "device" coupled with a function is a proper definition of structure and is therefore within the requirements of 35 U.S.C. 112, last paragraph."

While the above quoted law is relatively old, appellant has seen no indication that it has been overturned. In fact, the final paragraph of 35 U.S.C. 112 still allows means plus function claims, that is, structure defined by function. This is especially true in situations where the structure is hard to define. For example,

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constructing a pouch with a layer of plastic material to define an insulated and substantially water impermeable food warming chamber is not functional or indefinite simply because it differentiates the structure from a case for protecting fragile objects (e.g. Attaway). In this instance "an insulated and substantially water impermeable food warming chamber" is specific structure not a statement as to what the structure does. In fact, what the structure does is warms food, which is substantially different than the fact that the structure is a food warming chamber. The difference clearly differentiates the present structure from the precepts of *Hewlett-Packard Co. v. Bausch & Lomb Inc.* 909 F.2d 1464, 1469, 15 USPQ2d 528, 531 (CCPA 19599).

Thus, the five allegedly indefinite statements are not indefinite and, when considered in accordance with well established Patent Law and the English language, describe specific structure. Further, the language describing the structure is not functional since it describes the structure and not what the structure does (e.g. a food warming chamber versus a chamber for warming food). Finally, even if, arguendo, the language is functional the Examiner must consider it in accordance with the well established precepts of Patent Law cited above. Therefore,

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applicant believes that the indefinite argument has been overcome and the rejection under 35 U. S. C. 112, second paragraph, should be dropped.

35 U.S.C. § 103

Claims 1-4, 8-10, and 14-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Attaway (USP 5,775,530) in view of either Stewart (USP 5,692,660) or Goryl (USP 5,967,390). Claims 5-7, 11-13, and 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Attaway (USP 5,775,530) in view of either Stewart (USP 5,692,660) or Goryl (USP 5,967,390) and further in view of Anderson et al. (USP 4,919,300). Claims 5-7, 11-13, and 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Attaway (USP 5,775,530) in view of Anderson et al. (USP 4,919,300). Applicant respectfully traverses all of these rejections.

Claim 1 clearly specifies "the pouch being constructed to define an insulated and substantially water impermeable food warming chamber". Similarly, claim 8 states "a substantially water impermeable plastic film pouch defining

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a food warming chamber". Thus, a food warming chamber is a specific element of these claims. Attaway does not disclose or even suggest a food warming chamber and, therefore, cannot be modified by other citations that do not suggest food warming chambers to provide a modified food warming chamber.

The Examiner argues that "Attaway does not need a disclosure that it can be used for food because the claims do not require any structural feature specifically adapting it for food". Applicant believes, respectfully, that this contention is erroneous. Taking either claim 1 or 8 as an example, the entire claim is drawn to "Apparatus for keeping food warm and moist". Applicant again stresses that all of the words of the claim must be considered, "All words in a claim must be considered in judging patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 165 USPQ 494. 496 (CCPA 1970). If the entire claim is considered, it clearly defines structure not included in Attaway.

For example, claim 1 states "a pouch including a layer formed of a film of plastic material to provide water impermeability" and claim 8 states "a substantially water

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impermeable plastic film pouch defining a food warming chamber". First it must be noted that the film of plastic provides water impermeability. Attaway does disclose nylon material on the inner and outer surfaces of his neoprene walls. However, nothing in his disclosure even remotely suggests that the nylon material makes the enclosure water impermeable. Nylon material comes in many forms (e.g. nylon stockings) many of which are not impermeable. In fact, nylon cloth generally must be treated to make it waterproof or impermeable to water. Since Attaway does not disclose or suggest "a substantially water impermeable plastic film pouch" he does not disclose the same structure as claims 1 and 8.

The Examiner argues that each of Stewart and Goryl disclose containers having a layer of waterproof nylon plastic material. To justify this conclusion he states:

It would have been obvious to one of ordinary skill in the art at the time the invention was made to make Attaway's nylon layers waterproof, as taught by either Stewart or Goryl, because waterproof material would have prevented the contents of Attaway's container from getting wet and rusting.

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The Examiner may be correct in assuming that it would be obvious to waterproof the protection case of Attaway in view of the article carrying bag of Stewart. However, his argument proves why, specifically, they are non-analogous art. The claims specifically set forth a food warming chamber that is designed and constructed to keep food warm and moist. People skilled in the food industry practically never worry about the food rusting and it is desirable to keep most foods moist. Thus, the Examiner's rationale for combining the citations might make sense to those skilled in the packing or carrying arts but are directly contrary to the thinking of those skilled in the food art.

Claim 1 now specifically states "the partial enclosure caused by the passive, non-sealing engagement between the lips and the food warming chamber being constructed to inhibit a build-up of moisture vapor produced from warm food disposed in the warming chamber for preventing warm food disposed in the warming chamber from becoming soggy and to allow enough moisture vapor to remain in the warming chamber for keeping warm food disposed in the warming chamber moist". Claim 8 specifies "the partial enclosure caused by the passive, non-sealing engagement between the lips and the food warming chamber being constructed to

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provide a partial vapor lock in the food warming chamber". Applicant does not believe that Attaway can provide this structure, since his case is specifically designed with "inside dimensions smaller than said fragile object" (Attaway, claim 1), which would hold the upper and lower portions rigidly in place. No one (except possibly Attaway) could possibly tell from the Attaway disclosure what would happen if warm food were placed in his case. Certainly, nothing suggests that a partial vapor lock (specific structure) would be created at the opening between his top and bottom portions. Thus, since Attaway does not disclose or suggest "a partial vapor lock" claims 1 and 8 are not obvious in view of Attaway.

Claim 1 clearly specifies "the pouch being constructed to define an insulated and substantially water impermeable food warming chamber". Similarly, claim 8 now states "a substantially water impermeable plastic film pouch defining a food warming chamber". Thus, a food warming chamber is a specific element of these claims and the Examiner's rationale as to rusting and keeping the interior dry is a classic example of why that is important. One skilled in the art of the food industry will look at art much different from one skilled in the art of packing or

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carrying items. Neither Attaway, Stewart, nor Goryl disclose or even suggest a food warming chamber.

Applicant must restate his argument that all three patents, e.g. Attaway, Stewart, and Goryl, are non-analogous art. The Examiner must determine what is "analogous prior art" for the purpose of analyzing the obviousness of the subject matter at issue. "In order to rely on a reference as a basis for the rejection of an applicant's invention the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problems with which the inventor was concerned." *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). The Examiner himself admits that those skilled in the art pertaining to any of Attaway, Stewart, and Goryl will worry about rust and keeping stored devices dry.

The Examiner then disregards major portions of applicant's argument "because they rely on function only and do not point out any structural feature not shown by Attaway." Applicant strongly objects to this action. First, any and all arguments previously stated are included herein by this reference. Second the language that the

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Examiner alleges is functional describes specific structure.

Applicant believes that the determination as to whether language in a claim is functional or structural is not a decision that can be made without some supporting basis or rational. That is, functional language cannot be a unilateral decision but must have some basis in fact or law. For example, in the case of *In re Casey*, 152 USPQ 235 (CCPA 1967) the Court dealt with a case in which a taping machine was claimed and the claims included references to adhesive tape handling. The Court upheld the rejection stating that "the references in claim 1 to tape handling do not expressly or impliedly require any particular structure in addition to that of Kienzle." The perforating device had the structure of the taping device as claimed, the difference was in the use of the device, and "the manner or method in which such machine is to be utilized is not germane to the issue of patentability of the machine itself."

Applying this case law to applicant's claims: First, it is clear from Attaway's disclosure and drawings, as well as the Examiner's interpretation of the operation, that

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Attaway's structure does not, and cannot, operate like applicant's structure. Second, the alleged functional language in applicant's claims does not describe a different use for applicant's structure nor does it describe "the manner and method" in which the structure is to be utilized. The Examiner maintains that the controversial limitations are functional "statements of function and intended use". The determination that the language is functional with no basis in law or fact is error. The controversial limitations describe a specific structure and a result that will occur only if that specific structure is provided. This determination is proven by the fact that Attaway's structure cannot operate in the same fashion as the claimed structure.

"All words in a claim must be considered in judging patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 165 USPQ 494, 496 (CCPA 1970).

Taking the claimed invention as a whole (claim 1, for example), apparatus for keeping food warm and moist is specified. The apparatus comprises: (1) a pouch including a layer formed of a film of plastic material to provide water impermeability, (2) the pouch being constructed to

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define an insulated and substantially water impermeable food warming chamber, (3) the pouch having opposing substantially coextensive lips formed to provide a passive, non-sealing engagement between the lips causing a partial enclosure of the warming chamber, (4) the partial enclosure and the food warming chamber being constructed to inhibit a build-up of moisture vapor produced from warm food disposed in the warming chamber and to allow enough moisture vapor to remain in the warming chamber for keeping warm food disposed in the warming chamber moist.

Note that all four of the items specified are, or include, structure that specifically defines the invention. Taking these items one at a time:

Element (1) includes the structure: "a pouch including a layer formed of a film of plastic material". Clearly, this language has nothing to do with "the manner or method in which such machine is to be utilized", it simply states structure.

Element (2) includes the structure: "the pouch being constructed to define an insulated and substantially water impermeable food warming chamber". Clearly, this language has nothing to do with "the manner or method in which such machine is to be utilized", it simply states structure.

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Element (3) includes the structure: "the pouch having opposing substantially coextensive lips defining a food passage into the food warming chamber; the lips being formed to provide a passive, non-sealing engagement between the lips causing a partial enclosure of the warming chamber". Clearly, this language has nothing to do with "the manner or method in which such machine is to be utilized", it simply states structure.

Element (4) includes the structure: "the partial enclosure . . . "being constructed to inhibit a build-up of moisture vapor" which describes structure only. Also, the language "to allow enough moisture vapor to remain in the warming chamber for keeping warm food disposed in the warming chamber moist" describes the operation of the partial enclosure or the lips and, therefore, describes the structure in terms of the operation of the lips. The language does not describe the structure in terms of the manner or method in which such machine is to be utilized. Thus, this language comes within the precepts of *In re Echerd*, *In re Swinehart*, *In re Fuetterer* and not *Hewlett-Packard Co v. Bausch & Lomb Inc.* or *In re Casey*.

Nothing in the teachings of Attaway, Stewart, or Goryl suggest a warming chamber with lips that allow some

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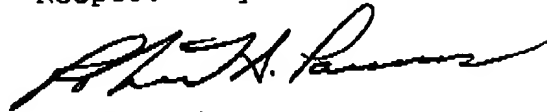
moisture to escape but retain some moisture from warm food. In fact the protection device of Attaway is formed to grip the protected object and would not react to any warm food placed in it. That is, once pulled into a protective orientation, there is no teaching or suggestion that the upper and lower portions might separate enough to allow moisture to escape from within, although they probably would stay sealed together sufficiently to prevent moisture from entering, as suggested by the Examiner. The bags of Stewart are designed to be permanently closed by draw strings. The inflatable box of Goryl might not even have a cover in some embodiments. Thus, no combination of these references would produce the claimed structure since none of the references are constructed to operate in a similar fashion.

Claims 5-7, 11-13, and 18-20 are dependent claims that are allowable for the same reasons set forth above. In view of the foregoing, applicant believes that all of the claims presently pending in this case are in condition for allowance, which action is earnestly solicited.

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Examiner's thorough and thoughtful consideration of this application is sincerely appreciated. Should there be any remaining issues, Examiner is cordially invited to telephone the undersigned for a speedy resolution.

Respectfully submitted,



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